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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,407	02/12/2004	Miguel-Angel Garcia-Martin	P17982-US1	5790

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EXAMINER	
HASHEM, LISA	
ART UNIT	PAPER NUMBER
2614	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/777,407	GARCIA-MARTIN ET AL.	
	Examiner	Art Unit	
	LISA HASHEM	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-5,7-13,16,17,20 and 21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-5,7-13,16,17,20,21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 2-5, 7-13, 16 and 20 have been considered but are moot in view of the new ground(s) of rejection.

2. Applicant's arguments, see Amendment, filed 1-7-2009, with respect to the rejection(s) of claim(s) 17 and 21 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. Please see all rejection(s) below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 11 recites the limitations "the used callback number" and "the established circuit switched call". There is insufficient antecedent basis for these limitations in the claim.

5. Claim 13 recites the limitation "the session" in lines 2 and 6. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 13 recites the limitation "the peer user terminal" in lines 7 and 9-10. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 2-5 and 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindgren in view of U.S. Pat. Appl. Publ. No. 2004/0252674 by Soininen et al, hereinafter Soininen.

Regarding claim 2, the method according to claim 5, wherein Lindgren in view of Soininen discloses further comprising utilizing the circuit switched call to provide one or more conversational bearers (Lindgren: section 0029, line 1 – section 0031, line 5; section 0048, line 1 – section 0050, line 5; Soininen: section 0028).

Regarding claim 3, the method according to claim 2, wherein Soininen discloses further comprising utilizing the packet switched session to provide non-conversational bearers established over said IP based packet switched network (section 0028).

Regarding claim 4, the method according to claim 5, wherein Soininen discloses at least one of the peer user terminals is a dual mode mobile terminal (Fig. 5) capable of using both said packet switched and circuit switched access networks (section 0002; 0028; 0039).

Regarding claim 5, Lindgren discloses a method of setting up a session (i.e. call session) between first (i.e. mobile station; Fig. 1, Fig. 4: SIP, 112; Fig. 3, 10; section 0017, line 1 –

section 0018, line 4) and second (i.e. network operator) user terminals of a communication system (Fig. 1; Fig. 4) (section 0001, lines 5; section 0015, lines 1-4), said session extending at least in part across a circuit switched access network (Fig. 1, Fig. 4: PSTN/ISDN) (section 0016, lines 9-14; section 0033, lines 6-10), the method comprising the steps of:

establishing a packet switched session (Fig. 1, Fig. 4: signaling radio access bearer set up) between a user terminal (Fig. 1, Fig. 4: mobile station) via an Internet Protocol, IP, based packet switched access network (Fig. 1, Fig. 4: GPRS (PS domain)) using a call control protocol (i.e. SIP) which is also used for setting up end-to-end packet switched sessions (section 0017, lines 3-7), wherein the step of establishing a packet switched session includes utilizing the Session Initiation Protocol, SIP, between at least one of the user terminals (i.e. mobile station) and a SIP server (Fig. 1, 4: Call server) of an IP Multimedia Core Network Subsystem (IMS) (Fig. 1, Fig. 4: (IP Multimedia Domain))

(section 0022, line 1 – section 0027, line 4; section 0039, line 1 – section 0046, line 4);

receiving a session initiation request (Fig. 1, Fig. 4: SIP INVITE request) at the SIP server (Fig. 1, Fig. 4: Call server), said session initiation request including a circuit switched telephone number (i.e. emergency phone number '911') and requesting establishment of at least one circuit switched conversational bearer (i.e. emergency call to a network operator connected to a PSTN network) (section 0022, line 1 – section 0027, line 4; section 0039, line 1 – section 0046, line 4);

associating the packet switched session with the circuit switched telephone number (i.e. SIP INVITE request includes an emergency indication such as: number of network operator '911') (section 0028, lines 1-8; section 0047, lines 2-8);

the SIP server notifying (i.e. sending an ISUP call) a gateway server (Fig. 1, Fig. 4: GW; section 0016, lines 9-14; section 0033, lines 6-10) of the request to establish the circuit switched conversational bearer (i.e. emergency call to network operator) (section 0029, lines 1-4; section 0048, lines 1-4); and the gateway server setting up a circuit switched call (i.e. emergency call) between the user terminals in parallel with the packet switched session (i.e. signaling radio access bearer set up) (section 0029, lines 1-6; section 0048, lines 1-6).

Lindgren discloses allowing an emergency call between a mobile station and a network operator utilizing an 'emergency indication' (section 0009, lines 1-5). However, Lindgren does not disclose first and second peer user terminals and establishing a packet switched session between both peer user terminals.

Soininen discloses a method of setting up a session between first (i.e. User A) and second (i.e. User B) peer user terminals (Fig. 5; Fig. 6: 90, 91) of a communication system (Fig. 1; Fig. 6) (section 0002; 0039), said session extending at least in part across a circuit switched access network (section 0002), the method comprising the steps of: establishing a packet switched session between the peer user terminals via an Internet Protocol, IP, based packet switched access network using a call control protocol (i.e. SIP) which is also used for setting up end-to-end packet switched sessions (section 0049), the step of establishing a packet switched session includes utilizing the Session Initiation Protocol, SIP, between at least one of the peer user terminals and a SIP server (i.e. SIP proxy; section 0010) of the mobile network (section 0046-0049); associating the packet switched session with a circuit switched telephone number (i.e. MSISDN number) (section 0042-0043); and setting up a circuit switched call between the peer user terminals in parallel with the packet switched session (section 0041-0043).

Again, Lindgren discloses the claimed method except Lindgren discloses different user terminals rather than first and second peer user terminals. However, the claimed feature of first and second peer user terminals and establishing a packet switched session between both peer user terminals was old and well known in the art. Soininen clearly teaches such concept.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user method of Lindgren to include first and second peer user terminals and establishing a packet switched session between both peer user terminals as taught by Soininen. One of ordinary skill in the art would have been lead to make such a modification of Lindgren to include first and second peer user terminals, such as the first and second peer user terminals of Soininen, to the communication system of Lindgren in order for both user terminals to be mobile terminals in order to allow call setup without requiring an 'emergency indication' and to establish a packet switched session between both terminals that are dual mode so that the network operator can utilize both packet switched and circuit switched access networks.

Regarding claim 7, the method according to claim 5, wherein Lindgren discloses said SIP server and said gateway server are co-located (Fig. 1, 4: IP Multimedia domain, Call server, GW) (section 0016, lines 9-14; section 0033, lines 6-10).

Regarding claim 8, the method according to claim 5, wherein Lindgren discloses the gateway server provides interworking between the circuit switched call (i.e. emergency call to a network operator connected to a PSTN network) and the packet switched session (i.e. signaling radio access bearer set up) (section 0029, lines 1-6; section 0048, lines 1-6).

Regarding claim 9, the method according to claim 8, wherein Lindgren discloses following notification (i.e. sending an ISUP call) from the SIP server, the gateway server notifies

said at least one of the peer user terminals (i.e. mobile station) of a callback telephone number (i.e. address of gateway) (section 0029, lines 4-7; section 0048, lines 4-7), and the peer user terminal calls that number to initiate the circuit switched call with the gateway server (section 0030, lines 1-9; section 0049, lines 1-9).

Regarding claim 10, the method according to claim 9, wherein Lindgren discloses at least one peer terminal (i.e. mobile station) is notified of the callback number is via the SIP server (section 0029, lines 4-7; section 0048, lines 4-7).

Regarding claim 11, the method according to claim 10, wherein Lindgren discloses the gateway server maps the established circuit switched call to the packet switched session based on the used callback number (section 0030, lines 1-5; section 0049, lines 1-5).

Regarding claim 12, the method according to claim 9, wherein Lindgren discloses the gateway server selects the callback number from a pool of available callback numbers (section 0029, lines 4-7; section 0048, lines 4-7).

Regarding claim 13, the method according to claim 5, further comprising Lindgren determining by the SIP server that said session requires setting up of a circuit switched call as a result of one or more of the following:

properties of the system known to the SIP server;

prior notification (i.e. SIP INVITE request) by said at least one of the peer user terminals (i.e. mobile station) (section 0027, line 1 – section 0028, line 12; section 0046, line 1 – section 0047, line 12);

information (i.e. SIP INVITE request includes an emergency indication such as: number of network operator '911') contained in the SIP signaling initiating the session (section 0028, lines

1-8; section 0047, lines 2-8);

properties defined for the peer user terminal;

prior notification from a visited network if a peer user terminal is roaming;

and prior notification from the radio access network used by the peer user terminal.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 16, 17, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. Appl. Publ. No. 2002/0002041 by Lindgren et al, hereinafter Lindgren.

Regarding claim 16, Lindgren discloses a Session Initiation Protocol server (Fig. 1, Fig. 4: Call server) for use in an Internet Protocol, IP, Multimedia Core Network Subsystem (Fig. 1, Fig. 4: (IP Multimedia Domain)) (section 0016, lines 9-14; section 0033, lines 6-10), the server comprising: means for receiving an INVITE request (Fig. 1, Fig. 4: SIP INVITE) from a user terminal (i.e. mobile station; Fig. 1, Fig. 4: SIP, 112; Fig. 3, 10; section 0017, line 1 – section 0018, line 4) (section 0027, line 1 – section 0028, line 12; section 0046, line 1 – section 0047, line 12), over an IP based packet switched domain (Fig. 1, Fig. 4; GPRS (PS domain)), initiating a packet switched session (Fig. 1, Fig. 4: signaling radio access bearer set up) (section 0022, line 1 – section 0027, line 4; section 0039, line 1 – section 0046, line 4); means for determining (i.e. SIP INVITE request includes an emergency indication such as: number of network operator '911') that the packet switched session requires setting up of at least one circuit switched

conversational bearer (i.e. emergency call to a network operator connected to a PSTN network) (section 0028, lines 1-8; section 0047, lines 2-8); and means for causing the at least one circuit switched conversational bearer to be set up in parallel with the packet switched session (i.e. signaling radio access bearer set up) (section 0029, lines 1-6; section 0048, lines 1-6).

Regarding claim 17, Lindgren discloses a gateway server (Fig. 1, Fig. 4: GW) for providing an interface between a circuit switched access network (Fig. 1, Fig.4: PSTN/ISDN) and a packet switched network (Fig. 1, Fig. 4: GPRS (PS domain)) (section 0016, lines 6-14; section 0033, lines 6-10), the gateway server having an interface towards a Session Initiation Protocol, SIP, server (Fig. 1, Fig. 4: Call server) of an Internet Protocol, IP, Multimedia Core Network Subsystem (Fig. 1, Fig. 4: (IP Multimedia Domain)) (section 0016, lines 9-14; section 0033, lines 6-10), said gateway server comprising: means for receiving from the SIP server, signaling (Fig. 1, Fig. 4: SIP INVITE) instructing the setting up of a circuit switched call (i.e. emergency call to a network operator connected to a PSTN network) over the circuit switched access network (Fig. 1, Fig.4: PSTN/ISDN) with a user terminal (i.e. mobile station; Fig. 1, Fig. 4: SIP, 112; Fig. 3, 10; section 0017, line 1 – section 0018, line 4) (section 0027, line 1 – section 0028, line 12; section 0046, line 1 – section 0047, line 12); and means for setting up the circuit switched call in parallel with a packet switched session (i.e. signaling radio access bearer set up) (section 0029, lines 1-6; section 0048, lines 1-6).

Regarding claim 20, the server of Claim 16, wherein Lindgren discloses further comprising means for notifying (i.e. sending an ISUP call) a gateway server (Fig. 1, Fig. 4: GW; section 0016, lines 9-14; section 0033, lines 6-10) upon determining that the at least one circuit switched conversational bearer (i.e. emergency call) (section 0029, lines 1-4; section 0048, lines

1-4) and causing said gateway server to provide a call-back number (i.e. address of gateway) to said user terminal (section 0029, lines 4-7section 0048, lines 4-7).

Regarding claim 21, the gateway server of Claim 17, wherein Lindgren discloses further comprising means for providing said user terminal with a call-back number (i.e. address of gateway) for said user terminal to call (section 0029, lines 4-7; section 0048, lines 4-7) to initiate the circuit switched call with said gateway server (section 0030, lines 1-9; section 0049, lines 1-9).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

12. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LISA HASHEM whose telephone number is (571)272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or

relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lisa Hashem/
Examiner, Art Unit 2614
March 27, 2009